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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,407	07/06/2000	Junichi Umehara	9366/203	7124

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,407

Applicant(s)

UMEHARA, JUNICHI

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Limitation of claim 35, "printing data is printed on CD ROM" is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure teaches that printing data is printed on a label instead directly on CD ROM.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 recites the limitation "said consumer identification information" and "said printer identification information" in lines 27 and 28 respectively, page 12. There is insufficient antecedent basis for this limitation in the claim.

With regards to the limitations of claims 6 (h), 22 (h), and 27 (d), the limitation "replenishing said printer with supplies" is unclear as how the supplies can be replenished on an online electronic communication.

Claim 7 recites the limitation "said image file" in lines 8-9, page 13. There is insufficient antecedent basis for this limitation in the claim. In claim 1 there is no reference of image file. Since claim 8 is dependency of claim 7 and claim 10 is dependency of claim 8, claims 8 and 10 will inherit the deficiency of claim 7 and are also rejected. For further art rejection, examiner has considered that identification indicia data is transmitted along with electronic certificate data.

Claim 9 recites the limitation "said image file" in lines 20-21, page 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "said user" in lines 14, page 14. There is insufficient antecedent basis for this limitation in the claim. Since claim 17 is dependency of claim 16 it will inherit the deficiency of claim 16 and is also rejected.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10 Claims 1-5, 7-9, 14,16-17, 20-21, 23-26, 28-29, 30-31, 33-35, 41, 46-56, 60, and 62-63 are rejected under 35 U.S.C. 102(e) as being clearly by anticipated by Ryan Jr. (US Patent 6,064,993), hereinafter referred to as Ryan.

With regards to claims 1-5, 20-21, 23-26, 30-31, and 46-56, Ryan teaches a method, a system and a printing device for conducting electronic transactions comprising: establishing a first communication connection to a provider from a consumer, and said communication connection is via Internet or optical communication or wire less medium, submitting a request for transaction with consumer's identification and printer identification information, provider processing said transaction and generating electronic certificated data, establishing a second communication by provider to consumer to transmit said authorized electronic certificate data and printing instructions to the consumer's printer without involvement of a consumer or a consumer's computer, and provider controlling the printing of an electronic certificate on the consumer's printer, acknowledging receipt of said printing data directly to said remote provider, (at least see col.3, line 36-col.5, line 36 & Figs.1-2. Note: Data center 20 corresponds to the provider in the application. Indicia data corresponds to electronic certificate data and the printer module at the consumer's end prints it. The printing of

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electronic certificate data at the consumer's printer is controlled by the PSD at Data center without involvement from consumer or consumer's computer the data center verifies that the printer module is authorized to print that authorized document data (at least see col.3, lines 40-45). At step 135, Fig.2, printer acknowledges receipt of the printing data from the provider directly. Col.4, lines 58-60 teach communication connection is via Internet or optical communication or wire less medium. Note: It is inherent that printers would function in response to drivers either on the resident driver or to a remote driver.).

With regards to claims 7-9, 28-29, Ryan further teaches providing an identification indicia for printing on said electronic certificate, transmitting it to the consumer's printer with the image file and printing the identification indicia on said electronic certificate, confirming that said indicia was printed on said electronic certificate and maintaining print-confirmation for said electronic certificate by said provider (at least see col.3, lines 49-col.4, lines 24, col.5, lines 9-29, and col.5, line 58-col.6, line 8). Ryan also discloses printing authentic certificates of different dimensions (at least see col.4, lines 30-32. Envelope and metering tape correspond to certificates of different dimensions).

With regards to claims 14, 33-35, and 60, Ryan teaches printing data on paper, plastic and on CD-ROM and printing also includes printing original postage label and an associated pick-up schedule label (at least see, col.4, lines 26-50, "...print directly on envelopes or meter tape.....label printer ". Note: label printer can print postage label as well pick-up schedule label).

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With regards to claims 16-17, 41 and 62-63, Ryan discloses requesting the user to make payment and print original receipt (col.5, lines 46-57).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 10, 11-13, 15-19, 22, 27, 38-40, 42-45, 57-59, and 61, 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan.

With regards to claims 6, 22, and 27, Ryan teaches a method and system for conducting electronic transactions as disclosed in claim 1, 20 and 23 and analyzed above. Ryan does not teach confirming the said printer has sufficient supplies and replenishing said printer with supplies. Official Notice is taken of the notoriously known concept and benefits of confirming the said printer has sufficient supplies and replenishing said printer with supplies. It is knowledge generally available that in order to print printer must be equipped with all supplies and if any supplies like ink cartridges and paper or medium on which printing is to be done are not there or exhausted then they have to be replenished. Doing so would ensure to execute the functions of the printer to print the desired indicia and would not delay or stop the work.

With regards to claims 42-45, their limitations correspond to the limitations of claim 6 and are similarly analyzed and rejected.

With regards to claim 10, Ryan teaches a method for conducting electronic transactions as disclosed in claim 1, and analyzed above. Ryan does not teach using bar code for identification indicia. Official Notice is taken of the notoriously known concept and benefits of printing bar codes to represent binary information for numbers, letters, or a combination of two, on books, grocery, items, merchandise, etc., that can be read by an optical scanner. Doing so ensures a rapid and error-free input to identify an item, as described above.

With regards to claims 11-13, 15, 18-19, 38-40, 57-59, 61, 64-65, Ryan teaches a method and a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it as disclosed in claims 1, 30, and 54 and analyzed above. Ryan does not disclose printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable available printers. Note: disclosure admits using suitable printers to print these items (page 6, lines 6-10 and page 10, lines 6-11) and does not teach the special means required for each time of item listed above. It is, therefore, understood that applicant admits that suitable printers are a prior art available at the time of the invention to print these items if data is downloaded to these printers from a remote source. Ryan also discloses transmitting data from a remote source to a printer to print the desired indicia on any medium. Official Notice is taken of the concept and benefits of printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable

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available printers. Doing so would ensure a rapid, economical and error-free transaction of printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable available printers.

6. Claims 32, and 36-37 are, rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan and further in view of Golden et al. (US Patent 5,761, 648).

With regards to claim 32, Ryan teaches a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it as disclosed in claim 30 and analyzed above. Ryan does not disclose means for canceling a printed material and for sending information about cancellation to said remote printer. However, Golden, in the field of remote printing of coupons on electronic networks, teaches disclose means for canceling a printed material and for sending information about cancellation to said remote printer (col.4, line 54-col.5, line 23, "...download new instructions.....change old instructions...modify instructions...Previously issued coupons could also be deleted.....expiration date.....Further, the issuer can update reports...based on the number of coupons selected 22, printed 23, and redeemed 24.....print commands 28.....". Note: Modification or deletion of earlier instructions for printing coupons correspond to canceling a printed material.). It would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Ryan and include the concept of canceling a printed material and sending information about cancellation to remote provider. Doing so would enable issuers of printed material to download new instructions to change the

printed material if required like expiration dates and to control the distribution, as suggested in Ryan (col.4, lines 60-67,, "....and commands to set expiration dates....limit coupon distribution by area....).

With regards to claims 36 and 37, Ryan/Golden teaches a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it, canceling the printing material as disclosed in claim 32 and analyzed above. Ryan/Golden does not disclose defacing said printed material and sending identification information read from said printed material or image of said printed material in defaced form to said remote provider. Official Notice is taken of both the notoriously well-known concept and benefits of disclose defacing said printed material and sending identification information read from said printed material or image of said printed material in defaced form to said remote provider. Doing so enables user, as in the case of canceled checks, tickets, unused coupons, promissory notes or any other agreement/document to present a proof of cancellation of the said certificates and to get the reimbursement if applicable.

7. Claims 66-67 are, rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan. and further in view of

With regards to claims 66-67, Ryan teaches a method, for printing original documents on a remote printer, as disclosed in claim 54 and analyzed above. Ryan does not disclose use of an intermediary while transmitting first and second electronic certificate data to a remote printer and that intermediary provides maintenance for the

printers. Official Notice is taken of the knowledge generally available about the concept and benefits of using intermediaries both in conventional business (without online) and online business are well known. Use of intermediaries in online business is expected to include online transmitting, downloading and printing of first and second electronic certificate data on a remote printer. By doing so, it will help to more efficient fulfillment of orders online and reduce administrative and home delivery costs of replenishing parts and supplies to the printer and improve the availability.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(i) US Patent 6385728 to DeBry relates to a network of computer systems, including but not limited to the Internet environment, and more specifically for securely printing a file retrieved from a separate file source in the network environment.

(ii) US Patent 6314521 to DeBry relates to a network of computer systems, including but not limited to the Internet environment, and more specifically for authenticating a printer in the network environment.

(iii) US Patent 6233684 to Stefik et al. relates to the field of distribution and usage rights enforcement for digitally encoded works, and in particular to identification of non-authorized copies of digitally encoded works that have been rendered.

(iv) US Patent 5822739 to Kara relates to system and method for remote postage metering.

(v) US Patent 5598477 to Berson relates to apparatus and method for issuing and validating tickets.

(vi) Kanan et al. " Marketing information on the I-way ", Association for computing Machinery, Communications of the ACM; New York; Mar 1998; and Stewart et al. " Internet marketing, business models, and public policy ", Journal of Public Policy & Marketing; Ann Arbor; Fall 2000, vol. 19, issue 2, pp: 1-13, extracted on Internet on 09/23/2002 from <http://proquest.umi.com> /pqdweb teach use of Intermediaries and the benefit of using them.

(vii) Carmen, Noel, " Easing LAN setups ", PC Week, 02/02/98, Vol.15 Issue 5, p 102, 1/3 p, 1 c extracted on Internet on 09/23/2002 from EBSCO HOST database teaches remote printing online.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
September 23, 2002


WYNN W. COGGINS
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